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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/670,549	09/27/2000	Koichi Sato	P19602	6759
7055	7590	09/29/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			VILLECCO, JOHN M	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/670,549	SATO, KOICHI
Examiner	Art Unit	
John M. Villecco	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 14 June 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 12-17 is/are allowed.

6)  Claim(s) 1,2,6,7 and 11 is/are rejected.

7)  Claim(s) 3-5 and 8-10 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 17 September 2000 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All   b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

## **DETAILED ACTION II**

### ***Response to Arguments***

1. Applicant's arguments filed June 14, 2004 have been fully considered but they are not persuasive.
2. Regarding claims 1 and 7, applicant has added the new limitation of stopping the recording operation while said recording operation is being executed. However, it is the position of the examiner that this newly added limitation does not overcome the prior art, in particular Nakao. Applicant points out that Nakao only discloses storing the image in the recording medium when the cross key is depressed. The examiner agrees with this point. However, the examiner still believes that the claim language is still broad enough that Nakao can still read on the claimed invention.

As pointed out by the applicant, the recording operation is defined in the claims as "recording operation by which image data is recorded in the recording medium". As disclosed in the previous office action:

A preview image is captured and before it is stored in the smart medium, a user determines whether or not the captured image is acceptable. If the image is not acceptable the user operates the cross key (46) to display the moving image again, inherently erasing the preview image. If the user decides to keep the image, the user operates the execution key (48), saving the image to the smart medium. The capture of the image is performed using the shutter button (26, col. 3, lines 1-5), which begins the recording process. The stopping of the image recording process is performed using the cross key (46). In this case the recording process is interpreted to be the entire process of collecting the image data, previewing the image, and making a determination as to whether or not to store the image.

The operation, as described in Nakao, results in an image being recorded in the recording medium. Therefore, it is the opinion of the examiner that Nakao does disclose a "recording

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operation by which said image data is recorded in a recording medium". Furthermore, the recording operation is interrupted while the recording operation is being executed and before the recording operation is completed, since the recording operation is defined as the entire process of previewing the image and then eventually storing the image in the recording medium. In summary, the examiner feels that the phrase "recording operation" is sufficiently broad enough for Nakao to be read on the claimed invention.

3. In response to applicant's argument that the examiner's conclusion of obviousness for the rejection based on Nakao and Suetaka is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

4. For the reasons stated above, the rejections from the previous office action will be repeated. Please see additional comments on the newly added claims

### ***Claim Objections***

5. Claims 3-5 and 8-10 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 12-17, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Nakao et al. (U.S. Patent No. 6,636,264).**

8. Regarding *claim 7*, Nakao discloses in column 5, line 52 to column 6, line 6 an electronic still camera capable of previewing an image. A preview image is captured and before it is stored in the smart medium, a user determines whether or not the captured image is acceptable. If the image is not acceptable the user operates the cross key (46) to display the moving image again, inherently erasing the preview image. If the user decides to keep the image, the user operates the execution key (48), saving the image to the smart medium. The capture of the image is performed using the shutter button (26, col. 3, lines 1-5), which begins the recording process. The stopping of the image recording process is performed using the cross key (46). In this case the recording process is interpreted to be the entire process of collecting the image data, previewing the image, and making a determination as to whether or not to store the image. Therefore, the recording operation is stopped while the recording operation is being executed and before the recording operation is completed. Inherently the camera would include a microprocessor or CPU for controlling the starting and stopping of the recording process.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakao et al. (U.S. Patent No. 6,636,264) in view of Suetaka et al. (U.S. Patent No. 5,032,930).**

11. Regarding *claim 1*, Nakao discloses in column 5, line 52 to column 6, line 6 an electronic still camera capable of previewing an image. A preview image is captured and before it is stored in the smart medium, a user determines whether or not the captured image is acceptable. If the image is not acceptable the user operates the cross key (46) to display the moving image again, inherently erasing the preview image. If the user decides to keep the image, the user operates the execution key (48), saving the image to the smart medium. The capture of the image is performed using the shutter button (26, col. 3, lines 1-5), which begins the recording process. The stopping of the image recording process is performed using the cross key (46). In this case the recording process is interpreted to be the entire process of collecting the image data, previewing the image, and making a determination as to whether or not to store the image. Therefore, the recording operation is stopped while the recording operation is being executed and before the recording operation is completed. Inherently the camera would include a microprocessor or CPU for controlling the starting and stopping of the recording process.

Nakao, however, fails to disclose that the stopping of the recording process is actuated by depressing the shutter button. Suetaka, on the other hand, discloses that it is well known in the art to use a shutter button to designate if an image should be erased. As shown in column 7, lines 30-33, Suetaka discloses that the shutter switch (17) is used to delete a designated image. By using the shutter button instead of the cross key of Nakao to delete image data, less buttons can be placed on the camera, further promoting miniaturization. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the shutter button of Nakao to designate whether or not to save or erase an image so space can be conserved and the camera can be miniaturized.

12. As for *claim 2*, Suetaka discloses that after an image is captured it can be deleted by depressing the shutter button (17). When used in conjunction with Nakao, it would have been obvious to cancel the recording operation using the shutter button.

13. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakao et al. (U.S. Patent No. 6,636,264) in view of Suetaka et al. (U.S. Patent No. 5,032,930) and further in view of Nishi (U.S. Patent No. 6,249,313).**

14. Regarding *claim 6*, as mentioned above in the discussion of claim 1, both Nakao and Suetaka disclose all of the limitations of the parent claim. However, neither of the aforementioned references discloses a photographing parameter setting processor, that after the recording operation is stopped, sets a first photographing parameter as a second photographing parameter. Nishi, on the other hand, discloses that it is well known in the art to use a parameter from a deleted image as a parameter for a next recording operation. More specifically, as shown

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in column 13, line 60 to column 14, line 3, Nishi discloses that the frame number of a deleted image is used as a frame number of the next picture taking operation. In this case, the parameter is interpreted to be a frame number. This feature allows a memory to fully control the number of frames left for recording and promotes efficient use of the memory. Therefore, it would have been obvious to carry over a parameter from a deleted image to a next image so that efficient memory use is utilized.

15. **Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakao et al. (U.S. Patent No. 6,636,264) in view of Nishi (U.S. Patent No. 6,249,313).**

16. Regarding *claim 11*, as mentioned above in the discussion of claim 7, Nakao discloses all of the limitations of the parent claim. However, Nakao fails to disclose a photographing parameter setting processor that, after the recording operation is stopped, sets a first photographing parameter as a second photographing parameter. Nishi, on the other hand, discloses that it is well known in the art to use a parameter from a deleted image as a parameter for a next recording operation. More specifically, as shown in column 13, line 60 to column 14, line 3, Nishi discloses that the frame number of a deleted image is used as a frame number of the next picture taking operation. In this case, the parameter is interpreted to be a frame number. This feature allows a memory to fully control the number of frames left for recording and promotes efficient use of the memory. Therefore, it would have been obvious to carry over a parameter from a deleted image to a next image so that efficient memory use is utilized.

***Allowable Subject Matter***

17. Claims 3-5 and 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. The following is a statement of reasons for the indication of allowable subject matter:

Regarding ***claim 3***, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest stopping the recording operation by depressing the shutter button a plurality of times within a predetermined period.

As for ***claims 4 and 9***, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest stopping the recording by stopping an exposure of the imaging device.

With regard to ***claims 5 and 10***, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest stopping the recording by stopping a reading operation of an image signal from the imaging device.

Regarding ***claim 8***, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the recording operation is stopped by operating both the recording operation stop switch and the shutter button.

Any response to this final action should be mailed to:

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or faxed to:

(703) 308-6306, (for formal communications; please mark "**EXPEDITED PROCEDURE**"; for informal or draft communications, please label "**PROPOSED**" or "**DRAFT**")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (703) 305-1460. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John M. Villecco  
September 15, 2004



TUAN HO  
PRIMARY EXAMINER